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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/864,558

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Michael D. Ellis

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EXAMINER

YIMAM, HARUN M

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

08/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/864,558

Applicant(s)

ELLIS, MICHAEL D.

Examiner

Harun M. Yimam

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 161-187, 192 and 193 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 161-187, 192 and 193 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/03/2007 has been entered.

Response to Arguments

2. Applicant's arguments filed 07/03/2007 have been fully considered but are moot in view of new grounds of rejection.

3. In response to applicant's argument (page 9, 2nd paragraph) that Rothmuller fails to show or suggest ranking programs in the favorite program list, applicant should note that it is Bedard and not Rothmuller who discloses ranking the program of interest based on how long the user has watched the program (Bedard—column 4, line 27 – column 5, line 6 and see figure 2) as addressed in the previous office action as well as the rejection of claims 161 and 174 below.

4. The applicant argues that Bedard fails to show or suggest any ranking schemes of the viewer's preferred channels based on the amount of time the programs of the channels have been watched adjusted by the duration of the programs and the types of the programs. (pg. 9, paragraph 3 - pg. 10, paragraph 1). Whereas the examiner recognizes the applicant's argument, the claims are broader than that argued, in that the claims merely recite a ranking scheme of the viewer's preferred channels based on: (a) the amount of time the programs of the channels have been watched adjusted by (b) **at least one of**: (1) the duration of the programs and (2) the type of the programs. As such, Bedard teaches a ranking scheme of the viewer's preferred channels based on: (a) the amount of time the programs of the channels have been watched adjusted by the type of the programs, in that Bedard teaches a viewing unit scheme for measuring the amount of time the viewer watches a program (col. 4, ll. 5-14) and (b) the type of program (see categories of figure 2), which meets the claimed limitations.

5. In response to applicant's argument (page 10, paragraph 2) that the explicit designation of an information to a watch list teaches away from "automatically adding the program of interest to the watch list." The examiner disagrees in that one ordinary skill in the art would recognize that there exist passive and active means for creating lists and a mere alternate type of list is not an explicit "teaching away." In addition, the added limitation of "ranking... adjusted by at least one of the duration of the programs and the type of program" has been addressed above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 161 – 165, 168 – 170, 173 – 178, 181 – 183, 186 and 187 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothmuller (US 5,635,989) in view of Bedard (US 5,801,747).

Considering claims 161 and 174, Rothmuller discloses a system and method for adding a program of interest to a watch list using an interactive television program guide at least partially implemented on user television equipment (column 4, lines 54-66), the user television equipment comprising:

a display device for displaying the program of interest (column 4, lines 54-58 and column 6, lines 60-66);

control circuitry (15 in figure 1) configured to: determine if a user has been watching the program of interest for a specified amount of time (column 5, lines 60-67 and column 6, lines 16-27),

determining a duration of the program of interest (by determining if the user has been watching the program of interest for a specified period of time, we also determine

Art Unit: 2623

the duration of each program watched by the user—column 5, lines 60-67 and column 6, lines 16-27); and

automatically add the program of interest to the watch list in response to the user having watched the program of interest for the specified period of time (column 5, line 59 – column 6, lines 1-4).

Rothmuller fails to disclose ranking the program of interest based on how long the user has watched the program of interest adjusted by at least one of the duration of the programs and the type of the programs.

In analogous art, Bedard discloses ranking the programs of interest included in the watch list depending on program type (category or subcategory—column 4, lines 49-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rothmuller's system to include ranking the program of interest based on how long the user has watched the program of interest and the type of program, as taught by Bedard, for the benefit of organizing the access of the watch list in accordance with the level of interest in each program.

As for claims 162 and 175, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to automatically remove the program of interest from the watch list in response to the

Art Unit: 2623

user not having watched the program interest for a second specified period of time (column 6, lines 48-56).

With regards to claims 163 and 176, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to remove the program of interest from the watch list in response to user input (column 7, lines 10-17).

Regarding claims 164 and 177, Rothmuller discloses a method for adding a program of interest to a watch list using an interactive television program guide.

Rothmuller fails to disclose ranking the program of interest based on how long the user has watched the program of interest.

In analogous art, Bedard discloses ranking the program of interest based on how long the user has watched the program (Bedard—column 4, line 27 – column 5, line 6 and see figure 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rothmuller's system to include ranking the program of interest based on how long the user has watched the program of interest, as taught by Bedard, for the benefit of organizing the access of the watch list in accordance with the level of interest in each program.

Considering claims 165 and 178, they are met by the combination of Rothmuller and Bedard. In particular, Bedard discloses that the control circuitry is further configured to place the program interest into the watch list in a position based on the ranking (Bedard—column 5, lines 6-33 and see figure 3).

Regarding claims 168 and 181, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to automatically display the watch list on the display device prior to the start of a program on the watch list (column 7, lines 39-45 and column 7, line 66 –column 8, line 2).

Considering claims 169 and 182, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to display at the top of the watch list a program that is about to start (since the favorite/watch list notification display comprises all programs that are about to start on different channels, the program displayed at the top of the favorite/watch list is a program that is about to start—column 7, lines 39 – column 8, line 2).

As for claims 170 and 183, Rothmuller discloses a method for adding a program of interest to a watch list using an interactive television program guide. Rothmuller

further discloses that the viewer can maneuver a cursor on a program guide so as to highlight the program of interest (column 6, lines 64-66).

However, Rothmuller fails to disclose that the control circuitry (Microprocessor—15 in figure 1) is further configured to allow the user to highlight a program on the watch list, and simultaneously display a program the user is watching, the watch list, and information related to the highlighted program on the display device.

In analogous art, Bedard discloses that the control circuitry is further configured to allow the user to highlight (by adding a border around the program/channel window) a program on the watch list (column 7, lines 58-60), and simultaneously display a program the user is watching (the primary television display—column 7, lines 58-60), the watch list (EPG comprising viewer preferred programs—column 7, lines 39-41), and information related to the highlighted program on the display device (see figure 5 and column 7, lines 28-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rothmuller's system to include highlighting a program on the watch list, and simultaneously display a program the user is watching, the watch list, and information related to the highlighted program on the display device, as taught by Bedard, for the benefit of allowing the user to work with the watch list and simultaneously watch the primary television display (column 7, lines 58-60).

Considering claims 173 and 186, they are met by the combination of Rothmuller and Bedard. In particular, Bedard discloses that the information related to the highlighted program is a description of the highlighted program (Bedard—see 508 in figure 5 and column 7, lines 34-35).

As for claim 187, it is met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the program of interest is a television program (column 6, lines 60-66 and column 1, lines 5-10).

8. Claims 166, 167, 179, and 180 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothmuller (US 5,635,989) in view of Bedard (US 5,801,747), as applied to claim 164 above, and further in view of Macrae (US 2003/0208756).

As for claims 166 and 179, Rothmuller and Bedard disclose a method for adding a program of interest to a watch list using an interactive television program guide.

Rothmuller and Bedard fail to disclose that the program of interest is a promotion.

In analogous art, Macrae discloses that the program of interest is a promotion (paragraph 0291, lines 15-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Rothmuller and Bedard to

Art Unit: 2623

include a promotion as the program of interest, as taught by Macrae, for the benefit of providing the user with various possible interests other than just television programs.

With regards to claims 167 and 180, Rothmuller and Bedard disclose a method for adding a program of interest to a watch list using an interactive television program guide.

Rothmuller and Bedard fail to disclose automatically removing the program of interest from the watch list when the promotion is no longer available.

In analogous art, Macrae discloses automatically removing the program of interest from the watch list when the promotion is no longer available (Macrae—paragraph 0124, lines 3-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Rothmuller and Bedard to include automatically removing a program in the absence of a promotion, as taught by Macrae, for the benefit of providing a means to advertisers to renew their advertisements (paragraph 0124, lines 8-9).

9. Claims 171, 172, 184, and 185 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothmuller (US 5,635,989) in view of Bedard (US 5,801,747), as applied to claims 170 and 183 above, and further in view of Billock (US 2002/0059581).

With regards to claims 171 and 184, Rothmuller and Bedard disclose a method for adding a program of interest to a watch list using an interactive television program guide.

Rothmuller and Bedard fail to disclose that the information related to the highlighted program is a video associated with the highlighted program.

In analogous art, Billock discloses that the information related to the highlighted program is a video associated with the highlighted program (paragraph 0078, lines 4-7 and paragraph 0080, lines 1-10 and paragraph 0064, line 3 - paragraph 0068, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Rothmuller and Bedard to include video as information related to the highlighted program, as taught by Billock, for the benefit of providing the user with different forms of information related to the highlighted program.

Regarding claims 172 and 185, they are met by the combination of Rothmuller, Bedard, and Billock. In particular, Billock discloses that the information related to the highlighted program is a video image associated with the highlighted program (Billock—paragraph 0064, line 3 - paragraph 0068, line 5).

10. Claims 192 and 193 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothmuller (US 5,635,989) in view of Bedard (US 5,801,747), as applied to claim 164 above, and further in view of Lawler (US 5,699,107).

With regards to claims 192 and 193, Rothmuller and Bedard disclose ranking the programs of interest included in the watch list based on the amount of time the programs have been watched (Bedard—column 4, line 27 – column 5, line 6 and see figure 2).

Rothmuller and Bedard fail to disclose allowing the user to set a reminder for a program of interest on the watch list.

In analogous art, Lawler discloses allowing the user to set a reminder for a program of interest on the watch list (column 2, lines 32-43, column 3, lines 37-50, column 11, lines 9-17 and see figures 8 and 9 as well as 140 in figures 6).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the combined system of Rothmuller and Bedard to include allowing the user to set a reminder for a program of interest on the watch list, as taught by Lawler, for the benefit of giving the user the option of recording the program or setting a reminder to view said program when broadcast.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harun M. Yimam whose telephone number is 571-272-7260. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HMY


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PRIMARY PATENT EXAMINER